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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,732	12/21/2000	Waldemar Kiener	(MM) 54 039	6906
7590	04/19/2004		EXAMINER	
M. ROBERT KESTENBAUM 11011 BERMUDA DUNES, NE ALBUQUERQUE, NM 87111			GOFF II, JOHN L	
			ART UNIT	PAPER NUMBER
			1733	23
DATE MAILED: 04/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

A5

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/746,732	KIENER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	John L. Goff	1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 January 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-13 and 15-24 is/are pending in the application.  
 4a) Of the above claim(s) 13 and 15-24 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1 and 3-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/9/04 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 1/17/03 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The correction to the drawings will not be held in abeyance.

### ***Claim Objections***

4. Claims 1 and 3-12 are objected to because of the following informalities: In claim 4, line 1 delete "Process according Claims//s// 1" and insert therein - - Process according to Claim 1 - -.

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In claim 8, line 2 delete “[7]”. In claim 8, line 2 delete “sued” and insert therein -- used --. In claim 9, line 2 delete “[7]”. In claim 10, line 2 delete “[7]”. In claim 10, line 3 delete “provide” and insert therein -- provided --. In claim 11, line 2 delete “[7]”. In claim 11, line 2 after “(22,22)” insert -- ) --. In claim 11, line 4 delete “(22//;// ,22’)” and insert therein -- (22,22’) --. In claim 11, line 5 delete “the”. In claim 11, line 6 after “processing” insert -- . --. In claim 12, line 2 delete “[7]”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 3-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 requires “at least one supporting film (23) on the other side of the at least one polymer film (17) is delaminated of the laminate (44), and at least one substrate (19) is laminated on the other side to the at least one polymer film (17) by an adhesive and subsequently exposed to crosslinking-active UV radiation.” This limitation is unclear and confusing in that it requires delaminating a film on the other side of polymer film (17) and then laminating a different film on the other side of polymer film (17) such that the claim appears to suggest the side of polymer film (17) that is delaminated is not the same side that is subsequently laminated on. It is suggested that for clarity and to remove the 35 USC 112 rejection the claim be amended in the following manner, delete “at least one supporting film (23) on the other side of the at least one

polymer film (17) is delaminated of the laminate (44), and at least one substrate (19) is laminated on the other side to the at least one polymer film (17) by an adhesive and subsequently exposed to crosslinking-active UV radiation." and insert therein - - at least one supporting film (23) is delaminated one a second side of the laminate (44), after which at least one substrate (19) is laminated on the second side by an adhesive and subsequently exposed to crosslinking-active UV radiation."

***Claim Rejections - 35 USC § 103***

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 3, 4, and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al. (U.S. Patent 4,389,472) in view of and the admitted prior art (Specification pages 1-2).

Neuhaus et al. disclose a method for forming tamperproof documents (documents that cannot be falsified such as credit cards, company cards, etc.) by laminating an information carrier with a plastic foil on one or both sides wherein the plastic foil has an adhesive layer that is hardened by UV radiation (Column 1, lines 5-7 and 53-66 and Column 7, lines 33-35 and

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Column 12, lines 31-37). Neuhaus et al. teach the method comprises providing a supply roll of plastic foil including a layer of UV curable adhesive (e.g. polyethylene), corona discharge treating the plastic foil, providing an information carrier (e.g. photo-polymer film), continuously laminating the information carrier on one or both sides with the plastic foil to form a laminate, exposing the laminate to UV radiation to cure the adhesive, and then cutting the laminate into individual tamperproof documents such as credit cards (i.e. further processing into forgery-proof documents) (Column 9, lines 49-50 and Column 10, lines 3-10 and 30-43 and Column 11, lines 17-26, 28-36, and 53-56). Neuhaus et al. are silent as to using an information carrier provided on each side with a protective/supporting film that is removed prior to laminating with the plastic foil. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the information carrier taught by Neuhaus et al. one that is provided with protective/supporting films during its production as it was well known and conventional in the art to provide an information carrier with these films during production for protection/support of the information carrier prior to its application (the films being removed prior to application) as shown for example by the admitted prior art.

Regarding claims 1 and 7, Neuhaus et al. as modified by the admitted prior art are silent as to delaminating/laminating each side of the information carrier in a sequential or simultaneous manner. However, it would have been well within the purview of one of ordinary skill in the art at the time the invention was made to process each side of the film separately or together as only the expected results would be achieved, i.e. either method would produce the same product.

Regarding claim 10, Neuhaus et al. teach the information carrier includes a photo-polymer film. Neuhaus et al. do not specifically recite a hologram. However, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to use as the photo-polymer layer taught by Neuhaus et al. a hologram as it was well known and conventional in the art to use as the photo-polymer layer in an information carrier a hologram as shown for example by the admitted prior art wherein only the expected benefits (e.g. increased security of the information layer) would be achieved.

The admitted prior art discloses known processes for producing forgery proof documents. The admitted prior art teaches that information carriers (e.g. polymer films such as holograms) are provided with protective/supporting films on both sides during their production (Specification page 2, lines 1-5). The admitted prior art further teaches removing the protective/supporting films prior to processing the information carrier into a forgery proof document due to the high processing temperatures of the protective films (Specification page 2, lines 7-13).

9. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al. and the admitted prior art as applied above in paragraph 8, and further in view of Ueda et al. (U.S. 5,755,919).

Neuhaus et al. and the admitted prior art as applied above teach all of the limitations in claims 4-6 except for a specific teaching of providing the information carrier to the process on a supply roll and performing the delaminating and laminating steps by passing the information carrier around a roll having delaminating, UV curing, and laminating stations placed around the circumference thereof. However, Neuhaus et al. are silent and are not limited to any particular means for supplying the information carrier such that it would have been obvious to one of ordinary skill in the art at the time the invention was made to supply the information carrier, e.g.

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photo-polymer film, taught by Neuhaus et al. as modified by the admitted prior art from a supply roll as it was well known and conventional in the art to supply photo-polymer film to a delaminating and laminating process in this manner as shown for example by Neuhaus et al. Furthermore, Neuhaus et al. are silent and are not limited to any particular laminating apparatus such that it would have been obvious to one of ordinary skill in the art to perform the method taught by Neuhaus et al. as modified by the admitted prior art using any well known and conventional apparatus for delaminating/curing/laminating on a film such as by the apparatus shown for example by Ueda et al. (including a roll for wrapping the film at least 180° having delaminating, UV curing, and laminating stations around the circumference thereof) wherein only the expected results would be achieved.

Ueda et al. disclose a process for delaminating and laminating on a photo-polymer film. Ueda et al. teach providing a photo-polymer film supply roll including protective/supporting films on both sides of the photo-polymer film, providing a roll having delaminating, UV curing, and laminating stations placed around the circumference thereof, supplying the photo-polymer film to the roll such that the film wraps the roll by at least 180°, removing at least one of the protective/supporting films, applying UV curing light to the photo-polymer film to duplicate a pattern in the roll on the photo-polymer film, laminating a second protective/supporting film onto the photo-polymer film, and then rolling the laminate to form an information carrier roll (Figures 6(a) and 6(b) and Column 7, lines 14-67 and Column 8, lines 1-20).

10. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al, the admitted prior art, and Ueda et al. as applied above in paragraph 9, and further in view of Butler et al. (U.S. Patent 3,822,838).

Neuhaus et al., the admitted prior art, and Ueda et al. teach all of the limitations in claims 11 and 12 except for a teaching on using a splicer and a storage device to ensure the continuous supply of information carrier, i.e. photo-polymer film. Butler et al. are directed to an apparatus for providing an uninterrupted supply of a web material from a supply roll to a machine that consumes the web at a high speed (Column 1, lines 7-10). Butler et al. teach that the apparatus comprises a splicer to automatically splice in a new roll when the running roll is depleted and an accumulator to ensure the web is continuously supplied to the web consuming machine when a new roll is being spliced (Figure 1 and Column 1, lines 10-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the method taught by Neuhaus et al. as modified by the admitted prior art and Ueda et al. the splicer and storage device taught by Butler et al. to ensure a continuous supply of photo-polymer film.

#### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1 and 3-12 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues "Neither Neuhaus nor Ueda motivate or suggest to one skilled in the art to combine these references to produce Applicant's claimed invention." The reference to Ueda has been removed from the rejection such that the rejection over claim 1 is now only Neuhaus in view of the admitted prior art, it being noted Ueda is still applied to teach dependent claims 4-6. It is additionally noted the rejection of claim 1 is taught by Neuhaus in view of the admitted prior art in that Neuhaus discloses a method for forming tamperproof documents by laminating an information carrier with a plastic foil on one or both sides wherein the plastic foil has an adhesive layer that is hardened by UV radiation, and

the admitted prior art discloses that information carriers of the type taught by Neuhaus et al. are provided with protective/supporting films on both sides during their production, the protective/supporting films being removed prior to processing of the information carrier, i.e. the laminating step taught by Neuhaus.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John L. Goff  
April 12, 2004

  
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